

Atty Dkt. No.: 10011076-1  
USSN: 10/087,035

### **REMARKS**

In view of the amendments and the following remarks, the Examiner is requested to allow claims 1-11, 22, 27, 28, 31-37, and 41, the only claims pending and under examination in this application.

Claims 38-40 have been cancelled. Because this amendment places the application in better form for consideration on appeal, entry of this amendment is respectfully requested.

### ***Claim Objections***

The Examiner has objected to the placement of commas in Claims 9 and 38. The Examiner is reminded that some latitude in the manner of expression should be permitted, and Examiners should not insist on their own preferences if the mode of expression selected by Applicant satisfies 35 U.S.C. § 112, 2<sup>nd</sup> paragraph. MPEP § 2173.02. Withdrawal of this objection is respectfully requested.

### ***Claim Rejections – 35 U.S.C. § 112, first paragraph***

The Examiner has asserted that the phrases *at least one probe specific for said curated sequence*, *said at least one vendor selected probe*, and *at least one of said vendor selected nucleic acid probes* are new matter. This rejection is respectfully traversed.

Claim language added by amendment does not have to be described in the specification *in ipso verbis* in order to satisfy the written description requirement of 35 U.S.C. § 112. Inherent support may satisfy the requirement absent specific disclosure. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 227 USPQ 177 (Fed. Cir. 1985),

Paragraph [0010] states: "providing, by the vendor, at least one additional array design parameter for the gene of interest." (emphasis added). Paragraph [0009] states: "array parameters provided by the vendor may comprise any

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parameters not provided by the customer that allow completion of an array design." Paragraph [0070] states: "[a]rray design parameters that are selected or provided by the vendor will typically be associated with computationally complex aspects of array design, i.e., nucleic acid probe sequencing parameters." Finally, paragraph [0072] (referring to Figure 2) states: "[i]n sub-event 170, probe selection is carried out based on the sequence information obtained in sub-events 150 and 160 [sequence curation]." When read together, the above statements provide adequate inherent support for the phrases rejected by the Examiner.

Withdrawal of this rejection is respectfully requested.

***Claim Rejections – 35 U.S.C. § 112, second paragraph***

Claims 38-40 were rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as allegedly being indefinite. Applicant has cancelled these claims. Withdrawal of this rejection is respectfully requested.

***Claim Rejections – 35 U.S.C. § 102***

Claims 1-11, 22, 27, 28, and 31-41 were rejected under 35 U.S.C. § 102(e)(1) as allegedly being anticipated by US Patent Application Publication No. 2003/0120432 to Zhou et al. (hereinafter "Zhou"). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Examiner asserted "that the terms 'curating' and 'sequencing' can be interpreted broadly...." Office Action at page 9. Further, the Examiner asserted that manufacturing the chip (page 4 of Zhou) represents curating a sequence.

The Examiner is reminded that during patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. MPEP § 2173.05(a).

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Applicant's specification at paragraph [0071] states that:

[s]equence curation typically involves checking the raw sequences from event 150 for errors such as incorrect sequences and incorrect 5'-3' ordering of sequences. Sequence curation 160 may also include removal of commonly repeated subsequences such as ALU and the like which would give rise to non-specific probes, and removal of any artifacts associated with sequence assembly, such as residual vector sequences.

Moreover, the ordinary dictionary definition for *curation* is curing or healing. Therefore, the Examiner's interpretation of the word is inconsistent both with Applicant's specification and the ordinary meaning of the word. Curation is not manufacturing. A mechanic who tunes an engine is not manufacturing the engine. Accordingly, Zhou does not disclose curating a sequence for a gene of interest.

Furthermore, Applicant reiterates that in Zhou (and in the provisional applications 60/288,429, 60/265,103, and 60/265,013 to which Zhou claims priority), the customer identifies probes that have been pre-selected by the vendor to include on an array. These vendor-selected probes come from the confines of the vendor's existing database. They are not probes selected specifically for the gene that is selected by the customer. In Zhou, if the vendor's database does not contain a probe for the customer-selected gene of interest, curating the gene sequence followed by selection of at least one probe specific for the curated sequence will fail, which means that Zhou is not disclosing Applicant's claimed invention.

Accordingly, Zhou does not identically disclose each and every element of Applicants' invention. As such, there is no anticipation. Withdrawal of this rejection is respectfully requested.

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### CONCLUSION

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 833-7770.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10011076-1.

Respectfully submitted,

Date: 2.9.06

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